



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

*Am*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,270	01/19/2001	Takamichi Sekido	01028/LH	1334

1933 7590 06/14/2005

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC  
220 5TH AVE FL 16  
NEW YORK, NY 10001-7708

EXAMINER

NGUYEN, CHAU T

ART UNIT PAPER NUMBER

2176

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/766,270

**Applicant(s)**

SEKIDO ET AL.

**Examiner**

Chau Nguyen

**Art Unit**

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005 and 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-5, 7, 11, 12, 22, 23, 27 and 29-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 7, 11-12, 22-23, 27 and 29-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Amendments, filed on 02/03/2005 and 03/10/2005, have been entered.

Claims 3-5, 7, 11-12, 22-23, 27 and 29-55 are presented for examination.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-5, 7, 12, 22-23, 29-33, 35-36, 38-42, 44-45, 47-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conrad et al. (Conrad), US Patent No. 6,307,545, and further in view of Takeda et al. (Takeda), US Patent No. 6,549,302.

4. As to claims 32, 41, 50 and 52 Conrad discloses a document handling apparatus for editing document file data, comprising:

a display which displays a list window area and a palette window area, said list window area including a plurality of document icons/thumbnails

Art Unit: 2176

corresponding to registered document files each including a plurality of pages, and said palette window area including page icons/thumbnails corresponding to the plurality of pages of at least one selected registered document file corresponding to at least one selected icon/thumbnail in the list window area (col. 1, lines 32-57 and col. 4, lines 5-28: a display system 18 displaying a plurality of windows enclosed identifiers or icons (thumbnails) such as icons 26 and 27 in window 23, icons 28-30 in window 24 and icon 31 in window 25, and icons are shown as graphical elements and icons may also be textual elements (document files), such as the name of the corresponding object (page), and col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure); and

a file controller which picks up desired pages of the plurality of pages of the at least one selected registered document file based on a designation of page icons/thumbnails in the palette window area corresponding to the desired pages (col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B)

However, Conrad does not explicitly disclose a file controller which unifies the picked up pages to generate a new document file and a corresponding new document file icon/thumbnail based on the picked up page. Takeda discloses a method that enables a user to divide (division process) one document into plural documents or combine (unification process) several documents into one (col. 14, line 18 – col. 15, line 53). It would have been obvious to one of ordinary skill in

Art Unit: 2176

the art at the time the invention was made to combine the teaching of Takeda and Conrad to include file operation means for executing a page division process or a page unification process of document file on the basis of an operation for the icon/thumbnails shown on said palette window area. Takeda provides an image processing system which can read manuscripts/documents and carry out image processing on the basis of the management information corresponding to the images of the read documents.

5. As to claim 3, Conrad-Takeda disclose wherein said each registered document file corresponds to file data stored in a memory (Conrad, col. 3, line 57 – col. 4, line 25 and col. 12, lines 15-47).

6. As to claims 4 and 22, Conrad-Takeda disclose wherein said file controller exports the new document file icon form the palette window area into the list window area (Conrad, col. 6, lines 10-31).

7. As to claims 5 and 23, Conrad-Takeda disclose wherein the new document file is outputted by an operation of the new document file icon/thumbnail in the palette window (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

8. As to claims 7 and 29, Conrad-Takeda disclose wherein said file controller creates a duplicated file of the at least one selected registered document

Art Unit: 2176

(Takeda discloses a method that enables a user to divide (division process) one document into plural documents or combine (unification process) several documents into one (col. 14, line 18 – col. 15, line 53. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Takeda and Conrad to include file operation means for executing a page division process or a page unification process of document file on the basis of an operation for the icon/thumbnails shown on said palette window area. Takeda provides an image processing system which can read manuscripts/documents and carry out image processing on the basis of the management information corresponding to the images of the read documents).

9. As to claim 30, Conrad-Takeda disclose displaying page icon/thumbnails corresponding to each divided page in the palette window area (Conrad, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure).

10. As to claims 33 and 42, Conrad-Takeda disclose wherein the new document file has a predetermined file format (Conrad, col. 4, lines 21-18).

11. As to claims 35 and 44, Conrad-Takeda disclose wherein said each registered document file includes icon/thumbnail data and a document file having a predetermined file format and including the plurality of pages of the registered

Art Unit: 2176

document file (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

12. As to claims 12, 31, 36 and 45, Conrad-Takeda disclose wherein the new document file has the predetermined file format, and the new document file is generated based on the document file having the predetermined file format (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

13. As to claims 38 and 47, Conrad-Takeda disclose wherein the picked up pages are picked up from one said selected registered document file (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

14. As to claims 39 and 48, Conrad-Takeda disclose wherein one of the picked up pages is picked up from one said selected registered document file, and another of the picked up pages is picked up from another said selected registered document file (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

15. As to claims 40, 49, 51 and 53, Conrad-Takeda disclose wherein the file controller generates the new document file in accordance with an operation of moving the new document file icon/thumbnail from the palette window area to the

Art Unit: 2176

list window area (Conrad, Abstract, col. 1, lines 32-57 and col. 4, lines 5-28: a display system 18 displaying a plurality of windows enclosed identifiers or icons (thumbnails) such as icons 26 and 27 in window 23, icons 28-30 in window 24 and icon 31 in window 25, and icons are shown as graphical elements and icons may also be textual elements (document files), such as the name of the corresponding object (page), and col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure).

16. As to claims 54 and 55, Conrad-Takeda disclose wherein the file controller generates the new document file based on the picked up pages (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

17. Claims 11, 27, 34, 37, 43, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conrad et al. (Conrad), US Patent No. 6,307,545 and Takeda et al. (Takeda), US Patent No. 6,549,302 as discussed in claims 3-5, 7, 12, 22-23, 29-33, 35-36, 38-42, 44-45, 47-55 above, and further in view of Stumbo et al. (Stumbo), US Patent No. 6,084,688.

18. As to claims 11, 27, 34, 37, 43 and 46, Conrad-Takeda disclose wherein the new document file has a predetermined file format (Conrad, col. 4, lines 21-



Art Unit: 2176

18) and Takeda discloses converting a scan document into an image document (col. 8, line 14 – col. 9, line 43). However, Conrad-Takeda do not explicitly disclose wherein said predetermined format is PDF format. Stumbo discloses converting an image into a portable document format or PDF (Stumbo, col. 1, lines 44-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Stumbo and Conrad-Takeda to include converting a document file into a PDF since the advantage of the portable document format is that it is page-independent and multi-page document converted into a PDF can be divided into subsets of data, and each subset of data corresponding to one of the multiple page images in the job or document. By doing this way, a number of individual page images in a multi-page document can be decomposed in parallel, thus reducing the amount of time required to decompose an entire multi-page document.

### ***Response to Arguments***

In the remarks, Applicant(s) argued in substance that

A) Takeda et al does not disclose, teach or suggest a display which displays a list window area and a palette window area.

As to point A, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See

Art Unit: 2176

*In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Examiner used Conrad reference to reject "a display which displays a list window are and a palette window area." Conrad discloses in col. 1, lines 32-57 and col. 4, lines 5-28: a display system 18 displaying a plurality of windows enclosed identifiers or icons (thumbnails) such as icons 26 and 27 in window 23, icons 28-30 in window 24 and icon 31 in window 25, and icons are shown as graphical elements and icons may also be textual elements (document files), such as the name of the corresponding object (page), and col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure.

B) Takeda et al does not disclose, teach or suggest "a stored document file is registered and page icons/thumbnails corresponding to a plurality of pages of the registered document file are displayed in the list window, whereby a document file having a predetermined file format corresponding to the registered document file is created in accordance with the registration, and whereby a new document file is created based on the document file with the predetermined file format in accordance with an editing operation".

As to point B, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See

Art Unit: 2176

*In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Conrad discloses in col. 1, lines 32-57 and col. 4, lines 5-28: a display system 18 displaying a plurality of windows enclosed identifiers or icons (thumbnails) such as icons 26 and 27 in window 23, icons 28-30 in window 24 and icon 31 in window 25, and icons are shown as graphical elements and icons may also be textual elements (document files), such as the name of the corresponding object (page), and col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure. Conrad also discloses in col. 2, lines 23-45 and col. 4, lines 21-28 that the identifiers (icons/thumbnails) may be textual or graphical data.

C) Conrad et al does not disclose performing an editing operation of a document file.

As to point C, Conrad et al disclose in the abstract that a graphical user interface allows user to drag an object (document file) when the user rolls over a hot spot on top of an icon or text representing a closed enclosure.

19. Applicant's arguments filed 02/03/2005 have been fully considered but they are not persuasive. Please see the rejection and the response to arguments above.

Art Unit: 2176

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The examiner can normally be reached on 8:00 am – 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen  
Patent Examiner  
Art Unit 2176

*William L. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
6/9/2005